

REMARKS

Applicants have reviewed the Notice of Non-Compliant Amendment under 37 CFR 1.121 mailed on July 13, 2005. This response with amendment with the following remarks is a substitute and replacement for the Applicants' Response with Amendment filed on July 7, 2005. The present amendment includes the proper status identifier for each claim included. Specifically, the claim listings are made from the previous pending claims submitted on July 7, 2005. The Applicants respectfully submit that the Notice of Non-Compliant Amendment should be withdrawn.

Applicants have studied the Office Action dated April 7, 2005 and have made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-14 and 16-21 are pending. Claims 1-3, 5-7, 11-14 and 16 are amended, new claims 17-21 have been added and claim 15 has been cancelled without prejudice. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

(Page 4, para 2) rejected claims 1-14 under 35 U.S.C. § 102(e) as being anticipated by Knight (U.S. Patent No. 6,792,392).

(Page 2-8, paras 1-8) Rejection Under 35 U.S.C. § 102(e)

As noted above, the Examiner rejected claims 1-4, 6 and 8 under 35 U.S.C. § 102(e) as being anticipated by Knight (U.S. Patent No. 6,792,392). The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Knight.¹

¹ See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

POU920010020US1

10 of 17

09/941,306

The Applicants have amended independent claims 1, 5, 6, 10, 11, 12, and 16 to more clearly set forth the presently claimed invention. The Applicants will discuss claim 1 and note that claims 6, 11 and 12 contain limitations that correspond to those recited for claim 1 and that the following statements with regards to claim 1 also apply to claims 6, 11 and 12.

Independent claim 1 has been amended to more clearly recite that the storing, presenting and accepting are performed on a first processing system, while the plurality of monitors operate on a second processing system. Support for these amendments is found in the specification at, for example, page 6, lines 24-26. No new matter has been added by these amendments. The performance of these steps on a processing system that differs from the processing system on which the monitors operate is clearly different than the architecture taught by Knight and provides advantages over the architecture of Knight. The Knight reference teaches a computer system that includes performance monitoring DLLs that interoperate with the device driver and hardware components of the processing system being monitored. The Knight reference further teaches that configuration of these DLLs is performed by interactive processing with these DLLs. See, Knight, column 4, line 54 through column 5, line 14. The Applicants assert that the structure of the system taught by Knight precludes the separation of method processing steps as set forth in claim 1.

The Applicants have further amended claim 1 to more specifically recite the step of presenting that the presenting is performed "so as to illustrate prohibited monitor and event combinations and prevent selection of prohibited monitor and event combinations." Support for these amendments is found in the specification at, for example, page 8, lines 19-28. No new matter has been added by this amendment. The Applicants assert that the teachings of Knight are limited to presenting a dialog box "which illustrates the different ways the counter can be customized." Knight, column 4, lines 64-65. The invention presently claimed by amended independent claim 1 illustrates not only the ways that a monitor can be configured, but also illustrates how it cannot be configured. An example of such a presentation is illustrated in the application in, for example, FIG. 5. The presentation of the presently claimed invention

is advantageous since it allows a user to identify how multiple monitors can and cannot be used so as to make a more informed decision to allocate monitoring resources during configuration. These advantages are also discussed in the specification at, for example, page 4, lines 13-18.

The Applicants have further amended claim 1 to more clearly specify that the method accepts "a complete user selected set of monitor and event associations." Support for these amendments is found in the specification at, for example, page 7, lines 13-27. No new matter has been added by these amendments. The teachings of Knight include configuring, or customizing, a collection of performance counters. Knight, Column 4, lines 28-42. The configuring of these performance counters, however, is performed for individual performance counters and is not performed as an integrated configuration of all performance counters. The Applicants assert that the ability of the accept a complete user selected set of monitor and event associations supports a user's definition of a complete configuration of monitors in a way that allows easier tradeoffs and design decisions to be made by considering the allocation of all of the limited number of monitors among the multiple events that can be monitored.

The Applicants have also amended claim 1 to specify that the preparing prepares "a complete monitor profile based on the complete user selected set of monitor and event associations." Support for these amendments is found in the specification at, for example, page 7, lines 13-27. No new matter has been added by these amendments. This further supports the easy definition of a set of monitor and event associations wherein tradeoffs among the allocation of multiple monitors among the various events are able to be easily considered as a whole. Further, as discussed above, the Applicants assert that the Knight reference teaches configuration of each monitor by a user and does not teach or suggest "preparing a complete monitor profile" as is set forth for claim 1.

As stated above, amended claims 6, 11 and 12 contain limitations that correspond to those described above with respect to claim 1. For at least the reasons stated above, the Applicants assert that claims 1, 6, 11 and 12 distinguish over the Knight reference

and that the rejection under 35 U.S.C. §102(e) should be withdrawn.

With respect to claims 2 and 13, the Applicants have amended these claims to recite that the step of presenting "comprises the step of presenting a graphical interface to the user that contains a complete presentation of the entire set of allowable associations." Claim 7 has been similarly amended. Support for these amendments is found in the specification at, for example, page 8, lines 6-26. No new matter has been added by these amendments. The Applicants assert that this display allows a user to more easily and effectively perform the design tradeoffs of allocating monitors to events by evaluating current allocations and making a more comprehensive evaluation of what is not being monitored. The benefits of this aspect of the present invention are further described in the specification at, for example, page 9, lines 1-17. As discussed above, the Knight reference does not teach such a comprehensive display.

With respect to claims 3 and 14, the applicants have amended these claims to more clearly specify that "the graphical user interface only presents valid monitor-event combinations for a plurality of monitors." The benefits of this aspect of the present invention are further described in the specification at, for example, page 9, lines 1-17. Support for these amendments is found in the specification at, for example, page 8, lines 6-26. No new matter has been added by these amendments. As discussed above, the teachings of the Knight reference is limited to displaying events that can be monitored by the monitor being configured. Knight, column 4, lines 56-65. The Applicants assert that presenting the combinations for "a plurality of monitors" is not taught or suggested by the Knight reference.

Additionally, Applicants note that amended dependent claims 2-4, 7-9, and 13-14 depend from independent claims 1, 6, and 12, respectively. As discussed above, amended independent claims 1, 6, and 12 distinguish over the Knight reference. Since dependent claims include all of the limitations of the independent claims from which they depend, Applicants further assert that amended dependent claims 2-4, 7-9, and 13-14 also distinguish over the Knight reference as well. Therefore, Applicants respectfully assert that the Examiner's rejection under 35 U.S.C. §102(e) over Knight

POU920010020US1

13 of 17

09/941,306

should be withdrawn.

With respect to claims 5, 10 and 16, the Applicants have amended these claims to more clearly describe the invention set forth in those claims. The Applicants have amended claims 5 to specify that the steps of storing, accepting, verifying, and preparing are performed on a first processing system, while "the plurality of monitors operate on a second processing system." Claims 10 and 16 have been similarly amended. Support for these amendments is found in the specification at, for example, page 6, lines 24-26. No new matter has been added by these amendments. The Applicants assert that this separation is similar to that discussed above for claim 1 and the Applicants refer to those comments to describe how claims 5, 10 and 16 distinguish over the Knight reference.

The Applicants point out that amended claims 5, and 16 include a limitation similar to the limitation of "verifying, in the user interface process on the first processing system," that the selected set of monitor and event associations is a subset of the list of allowable associations" as is recited by claim 5. Claim 10 recites a similar limitation component for the monitor configuration generator. Support for these amendments is found in the specification at, for example, page 8, lines 15-18. No new matter has been added by these amendments. The Applicants point out that the originally filed claims 5 and 16 included a "verifying" step that was not addressed by the Examiner in the present office action since only claims 6 was considered in detail. Originally filed claim 10 also included the similar limitation component that was similarly not considered. The Applicants respectfully assert that the Knight reference does not teach or suggest a verifying step.

The Applicants have further amended claim 5 to include the step of "assembling, in response to verifying that the selected set of monitor and event associations is a subset of the list of allowable associations, a complete set of selected monitor and event associations." Support for these amendments is found in the specification at, for example, page 7, lines 13-27. No new matter has been added by these amendments. The Applicants assert that the Knight reference does not teach or suggest such an

assembling "in response to verifying" as is set forth for claim 5.

With further regards to amended independent claim 5, the Applicants assert that the Knight reference does not teach the step of "preparing, on the first processing system in response to the assembling, a monitor profile based on the complete set of monitor and event associations." Support for these amendments is found in the specification at, for example, page 7, lines 13-27. No new matter has been added by these amendments. The Applicants assert, as discussed above, that the Knight reference does not teach the step of assembling, as is set forth for claim 5. This therefore precludes performing the step of preparing in response to the assembling, as is further set forth in claim 5. Additionally, the Applicants assert that the Knight reference does not teach or suggest "preparing ... a monitor profile based on the complete set of monitor and event associations" when claim 5 is considered as a whole. The prior limitation of claim 5 sets forth the assembling of the "complete set of monitor and event associations." As discussed above, this assembling is not taught or suggested by the Knight reference.

Amended independent claims 10 and 16 contain limitations similar to those of claim 5. Therefore, amended independent claims 10 and 16 distinguish over the Knight reference for at least the same reasons discussed above with regards to claim 5. The Applicants therefore respectfully assert that the rejection of claims 5, 10 and 16 under 35 U.S.C. §102(e) should be withdrawn.

New Claims

The Applicants have added new claims 17 through 21. No new matter has been added by this amendment. Support for new claims 17 and 18 is found in the specification at, for example, page 5, lines 25-26. Support for new claim 19 is found in the specification at, for example, page 9, lines 4-8. Support for new claims 20 and 21 is found in the specification at, for example, page 8, lines 1-27 and FIGs 4 and 5. No new matter has been added by these amendments. The Applicants assert that the prior art of record does not teach or suggest, taken either alone or in any combination with one another, the combination of limitations as set forth in these claims when each of these claims is considered as a whole.

CONCLUSION

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

Applicants acknowledge the continuing duty of candor and good faith to disclose information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If the Examiner believes that there are any informalities that can be corrected by Examiner's amendment, or that in any way it would help expedite the prosecution of the patent application, a telephone call to the undersigned at (561) 989-9811 is respectfully solicited.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

The Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account **50-1556**.

Respectfully submitted,

Date: August 10, 2005
By: 
Jeffrey N. Giunta, Reg. No. 42,583
Attorney for Applicants

FLEIT, KAIN, GIBBONS, GUTMAN
BONGINI & BIANCO P.L.
551 N.W. 77th Street, Suite 111
Boca Raton, FL 33487
Tel (561) 989-9811
Fax (561) 989-9812